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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,773	01/21/2004	Terry Durand	8C20.1-220	3533
39513 7590 10/16/2007 GARDNER GROFF GREENWALD & VILLANUEVA, P.C. 2018 POWERS FERRY ROAD SUITE 800 ATLANTA, GA 30339			EXAMINER KEEFER, MICHAEL E	
			ART UNIT 2154	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/761,773

Applicant(s)

DURAND ET AL.

Examiner

Michael E. Keefer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 14-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/11/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office Action is responsive to the response to election filed 9/19/2007 and the application filed 1/21/2004.

#### ***Election/Restrictions***

2. Applicant's election without traverse of Species I in the reply filed on 9/19/2007 is acknowledged.
3. Claims 11-13 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/19/2007.
4. The election requirement is made final.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 25-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

**Claims 25-26** are drawn towards a computer program. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition of matter. Instead, it includes functional descriptive material. Functional descriptive material does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or

object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 10 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 10 and 23, it is unclear how exactly a link of a sound file to an emoticon can be encoded as a MIME attachment. According to the specification, a sound file is simply included with the message encoded in MIME format, no mention of a "link" being encoded is mentioned, neither is any mention of the emoticon itself being encoded as a MIME attachment. For the purposes of prior art rejections, the Examiner is interpreting this limitation to be stating that a sound file encoded in the MIME format is included with the message.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-6, 8-9, 15-18, 20-22, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Isaacs et al. (US 2004/0215728), hereafter Isaacs.

Regarding **claims 1, 15, and 25**, Isaacs discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server ([0038], "The missing sound message may ... be requested ... from a central server...") for facilitating communications between the sender and the recipient, the method comprising the steps of:

linking a sound file to an emoticon contained in a sender-generated message; and (Fig. 3, step 144)

forwarding the emoticon and its link to the sound file to the recipient. (Fig. 3, 152, [0007] "Visual aids may be provided to aid users in learning the meaning of the earcons.")

Regarding **claim 2 as applied to claim 1**, Isaacs discloses:

at the recipient, displaying the emoticon and audibly playing the sound file linked to the emoticon. ([0007] "Visual aids may be provided to aid users in learning the meaning of the earcons.", [0036] discloses playing the sounds)

Regarding **claims 3 and 16, as applied to claims 1 and 15**, Isaacs discloses:

making a dynamic association, established by the sender, for that particular message being sent. (Fig. 3 discloses linking particular sounds to

particular icons creating specific 'earcons', which are particular messages made by the user dynamically.)

Regarding **claims 4 and 17 as applied to claims 1 and 15**, Isaacs discloses:

automatically generating a link according to the particular emoticon being sent. ([0031] discloses that a sound is automatically chosen based upon the icon chosen by the user for the message.)

Regarding **claims 5 and 18 as applied to claims 1 and 15**, Isaacs discloses:

automatically generating a link according to the combination of the particular emoticon being sent and the particular recipient. ([0021] discloses sending different sounds to different recipients depending upon the particular recipient (i.e. has that recipient received a message from the user within a certain amount of time, if not, link a sound file including the user's personal sound.)

Regarding **claims 6 and 20, as applied to claims 1 and 15**, Isaacs discloses:

wherein the step of linking is performed by the sender. (Fig. 3)

Regarding **claims 8 and 21, as applied to claims 1 and 15**, Isaacs discloses:

wherein the step of linking comprises attaching the sound file to the message, and wherein the step of forwarding comprises forwarding both the message and the sound file. ([0039] discloses sending a sound file with the message.)

Regarding **claims 9 and 22, as applied to claims 1 and 15**, Isaacs discloses:

creating a pointer to a sound file and attaching the pointer to the message.

([0037] discloses including a unique ID that indicates the sound file with the message.)

11. Claims 14, 24, 26, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Werndorfer et al. (US2004/0024822), hereafter Werndorfer.

Regarding **claims 14, 24, and 26**, Werndorfer discloses:

A method for playing an audio file associated with an emoticon contained in a message sent by a sender to a recipient, the method comprising:

analyzing a message received by the recipient to find an emoticon is contained in the message; and causing a sound file associated with an emoticon found in the message to be executed. ([0083]-[0085] discloses playing a sound file when a message contains a specific alphanumeric sequence (i.e. emoticon))

Regarding **claim 27**, Werndorfer discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for facilitating communications between the sender and the recipient, the method comprising the steps of:

at the recipient, displaying the emoticon and audibly playing a sound file linked to the emoticon. ([0083]-[0085] discloses playing sounds and displaying emoticons)

12. Claims 1, 7, 15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ostermann et al. (US 6963839), hereafter Ostermann.

Regarding **claims 1 and 15**, Ostermann discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for facilitating communications between the sender and the recipient, (Fig. 4(a), 4(b)) the method comprising the steps of:

linking a sound file to an emoticon contained in a sender-generated message; and forwarding the emoticon and its link to the sound file to the recipient. (Col. 8, lines 17-28 disclose linking video and audio to a sender-generated message containing emoticons. Col. 9 lines 59-61 disclose determining sounds to link with the message based off of emoticons. It is inherent that the message is forwarded to the recipient, or else there would be no reason to construct it at all. (Note recipients 72 and 76 in fig. 4a and 4b)

Regarding **claims 7 and 19 as applied to claims 1 and 15**, Ostermann discloses:

The linking is preformed on the server. (Col. 8 lines 17-28 disclose that the linking is done by a server.)

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1, 10, 15, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mages et al. (US 6463467), hereafter Mages.



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Regarding **claims 1 and 15**, Mages discloses:

A method of using an electronic communications network, in which a sender can send a message to a recipient, the network including a server for facilitating communications between the sender and the recipient, the method comprising the steps of: linking a sound file to an emoticon contained in a sender-generated message; and forwarding the emoticon and its link to the sound file to the recipient. (Col. 3 lines 5-32. disclose the MIME protocol, used in email, which inherently includes a sender, recipient, and email server. An email message is created including a graphic (i.e. an icon/emoticon) and audio, (i.e. the multi-part field described in lines 15-16, graphics and audio are disclosed in lines 5-6, the email is then sent to the recipient. The graphic and sound are linked because they are in the same message.)

Regarding **claims 10 and 23 as applied to claims 1 and 15**, Mages discloses:

forwards the emoticon and its link to the sound file in the form of an MIME-encoded attachment. (Col. 3, line 5 discloses using MIME encoded attachments.)

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Heikes et al. discloses a server system for storing groups of sounds and emoticons for different users..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Keefer whose telephone number is (571)

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270-1591. The examiner can normally be reached on Monday through Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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MEK 10/3/2007

Sumed from the  
SUPERVISORY PATENT EXAMINER  
NATHAN FLYNN